

## **REMARKS**

In response to the above-identified Office Action, Applicant submits the following remarks and seeks reconsideration of the rejections. In this response, no claims have been added, no claims have been cancelled, and no claims have been amended. Accordingly, Claims 1-30 are pending.

### **I. Claims Rejected Under 35 U.S.C. §103**

The Examiner has rejected Claims 1-4, 8-15, 18 and 19 under 35 U.S.C. §103 as rendered obvious by Pito, U.S. Patent No. 5,831,621 ("Pito") in view of Migdal, U.S. Patent No. 5,991,437 ("Migdal"). Applicants respectfully traverse this rejection.

It is not necessary to reach whether Pito teaches or suggests each of the things for which the Examiner relies on it. The Examiner acknowledges that Pito does not teach or suggest that the orientation, fixture and digitizer are physically independent units without a predefined relative position. Accordingly, the Examiner attempts to combine Migdal with Pito for this proposition. However, since Migdal explicitly eschews the use of an orientation fixture, at all this combination could only have been motivated by inappropriate hindsight. Applicants particularly refer to the Examiner to Column 5, Line 37, which reads: "Such an adjustment system frees the underlying scanning system from the cumbersome use of rotating platforms..." because Migdal explicitly teaches the desirability to free scanning system from an orientation fixture would be inappropriate to confine its teachings with those of Pito.

Moreover, even if combined, none of the calibration aspects taught by Migdal appear to teach or suggest the independence of an orientation unit and a digitizer

without a predefined relative position. Thus, not only because the references cannot be properly combined, but also because the references in combination fail to teach the invention claimed in Claim 1, Claims 1-4 and 8-12 are patentable over the references of record. It is respectfully requested that this rejection be withdrawn.

With respect to Claim 13, the Examiner continues to ignore the absence of teaching of using a linear CCD for the capture system as claimed. Accordingly, both because the references fail to teach at least this element of Claim 13 and because the references cannot be properly combined, Claims 13-15, 18 and 19 are allowable over the references of record. It is respectfully requested that the rejection be withdrawn.

The Examiner has rejected Claims 5-7, 16-17 and 30 under 35 U.S.C. §103 as being unpatentable over Pito in view of Migdal in further view of Vellacott, International Publication No. W0 96/02106 ("Vellacott"). Both because Vellacott fails to cure the deficiencies discussed above in connection with the corresponding independent claims (an analogous discussion applies to Claim 30) and because Vellacott exacerbates rather than mitigates the erroneous combination. It is respectfully requested that this rejection also be withdrawn.

The Examiner has rejected Claims 27-29 under 35 U.S.C. §103 as being unpatentable over Pito in view of Migdal in further view of Truc, U.S. Patent 6,421,079 B1 ("Truc"). Applicants respectfully traverse this rejection. With the addition of Truc, the Examiner again goes further a field to a nonanalogous art unit. The scanning of a filmstrip is not remotely analogous to the scanning of three-dimensional physical objects. In this combination of three references, none of which would be combined without the aid of hindsight looking back through Applicant's own disclosure, the Examiner attempts to cobble together what Applicants claim in Claims 27-29. At a

minimum, because the combination is inappropriate, this rejection should be withdrawn.

The Examiner has rejected Claims 20-26 under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,799,082 to Murphy, et al. ("Murphy"). Applicants respectfully traverse this rejection. The Examiner has maintained this erroneous rejection without comment on the arguments previously submitted by the Applicants. Those arguments are reproduced below for completeness.

Murphy teaches a download port 47 and the reception of a software or hardware key that allows information download. The Examiner has not indicated and Applicants have been unable to discern any part of Murphy that teaches that either the download or the reception of the key may occur over a network connection. Further, the Examiner has not identified and Applicants have been unable to discern any part of Murphy that teaches modifying these teachings to utilize a network connection. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for independent claim 23.

In regard to dependent claims 24-26, these claims depend from independent claim 23 and incorporate the limitations thereof. Thus, for the reasons mentioned in regard to independent claim 23, these claims are not obvious over Murphy. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 24-26 are requested.

### CONCLUSION


In view of the foregoing, it is believed that all claims now pending are now in condition for allowance and such action is earnestly solicited at the earliest possible date.

If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

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Dated: September 23, 2004

  
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**CERTIFICATE OF MAILING:**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 23, 2004.

  
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Susan M. Barrette

  
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Date